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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595

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IP DEPARTMENT  
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EXAMINER
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BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/215,804

Applicant(s)

GAVIN ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-14, 16-22, 24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 16-22, 24 and 26-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No: \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: amendment filed 8/14/2006, to the original application filed 12/18/1998.
2. Claims 1-6, 8-14, 16-22, 24, 26-34 pending. Claims 1, 5, 9, 13, 17, 21, 26 are independent claims.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996, in view of Pontin, Jason, TechSmith ships Win95 screen capture utility, InfoWorld January 15, 1996, Vol. 18, Issue 3, pages 1-3.

In regard to independent claim 1, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble "*A method of redacting content from a document in electronic form, comprising the steps of*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Abstract, Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 1 "*selecting a geometric area on the document for redaction, said geometric area having content comprising at least one image*", and "*representing said geometric area as one or*

*more annotation objects*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (i.e. image objects, annotation/redaction area objects, etc.) (Anderson Abstract, Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 “*identifying information in the document representing content and location and nature of content*”, and “*representing said identified information as one or more content objects, said one or more content objects comprising one or more image occurrence objects;*”).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 “*identifying content....to produce a redacted document.*”).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose “an output file” with said (image based) content not present, hence allowing a permanently redacted document to be producible from said output file. However, Pontin teaches SnagIt 32, a screen capture utility (Pontin page 1, paragraph 1, 2). When SnagIt 32 captures Anderson’s redacted document via screen shot capture, Anderson’s possible redacted layers are “flattened” into an image file (Pontin page 2 paragraph 9 - .gif, .jpeg, etc.). Since SnagIt also enables Microsoft Word to configure options and invoke captures via DDE (Dynamic Data Exchange) (Pontin page 2 paragraph 5), Anderson’s document can be captured by Word (via invoking a SnagIt screenshot), and the (now flattened image) pasted as an image object into a document. It is noted that once a typical edited Word document is saved, document edits cannot be undone (up to the point of Save). Anderson’s redacted image/document is now saved

in permanently redacted form. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Pontin to Anderson, providing Anderson the benefit of permanently saving the displayed image redactions within a final document in permanent form for ultimate security (preventing document reverse-engineering, etc.). (compare with claim 1 “*creating an electronic output file, said output file comprising said identified information except for portions of said information corresponding to said identified content, a redacted document being reproducible from said output file for display.*”).

**In regard to dependent claim 2**, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claim 2).

**In regard to independent claim 5**, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble “*A method of designating portions of a document for redaction, comprising the steps of*”).

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 5 “*displaying all or a portion of the document*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or redaction (Anderson Abstract, Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 5 “*designating a geographical region of the document for redaction*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column

2 lines 43-47). Anderson does not specifically disclose “saving” designations with the document, with said content not present, hence allowing a permanently redacted document to be producible from said output file. However, Pontin teaches SnagIt 32, a screen capture utility (Pontin page 1, paragraph 1, 2). When SnagIt 32 captures Anderson’s redacted document via screen shot capture, Anderson’s possible redacted layers are “flattened” into an image file (Pontin page 2 paragraph 9 - .gif, .jpeg, etc.). Since SnagIt also enables Microsoft Word to configure options and invoke captures via DDE (Dynamic Data Exchange) (Pontin page 2 paragraph 5), Anderson’s document can be captured by Word (via invoking a SnagIt screenshot), and the (now flattened image) pasted as an image object into a document. It is noted that once a typical edited Word document is saved, document edits cannot be undone (up to the point of Save). Anderson’s redacted image/document is now saved in permanently redacted form. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Pontin to Anderson, providing Anderson the benefit of permanently saving the displayed image redactions within a final document in permanent form for ultimate security (preventing document reverse-engineering, etc.). (compare with claim 5 “*saving the designations with the document*”).

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4). Anderson also teaches an Image Object, and a Graphics Object, comprising geometric areas of a page (Anderson Abstract, Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line “Object Area Position”) (compare with claim 5 “*wherein the step of designating comprises manipulating a frame displayed on the document, content....visible to the user during said step of manipulation, said content comprising at least one image.*”), teaching the manipulation and orientation (framing) of an object on a page.

Applying the above limitation regarding manipulation of a frame, to a redaction, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches application of overlays to both annotations and redactions (see Anderson Figure 5). Since a document annotation can be subject to redaction, it would have been obvious to add and/or combine the redaction overlay with the annotation overlay, providing the advantage of extra security via redaction of user annotations.

**In regard to dependent claim 6**, Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

**In regard to dependent claim 8**, Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches “include” structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of efficient batch (all at once) processing.

**In regard to claims 9-10**, claims 9-10 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-2, respectively and are rejected along the same rationale.

**In regard to claims 13-14**, claims 13-14, reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-6, respectively , and are rejected along the same rationale.

**In regard to claim 16**, claim 16 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 8, and is rejected along the same rationale.

**In regard to claims 17-18, 20**, claims 17-18, 20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1, 2, and are rejected along the same rationale.

**In regard to claims 21-22**, claims 21-22 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-6, and are rejected along the same rationale.

**In regard to claim 24**, claim 24 reflects the system comprising computer executable instructions used for performing the methods as claimed in claim 8, and is rejected along the same rationale.

**In regard to dependent claims 28-30**, Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with *"displaying all or a portion of a document"*).

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with *"manipulating a frame displayed on the document, content....visible to the user during said step of manipulation."*), teaching the manipulation and orientation (framing) of an object on a page.

**In regard to dependent claims 31-33**, Anderson does not specifically disclose replacement via "pixel by pixel". However, both Anderson and Pontin teach images (see Pontin page 9 paragraph 9). Since modification of images in an electronic document generally involve modification of its representative pixels, and since Pontin teaches permanent flattening of a file, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification, providing the benefit of image based redaction.

5. **Claims 3-4, 11-12, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, and Pontin, and further in view of Redax (hereinafter Redax), Web article by Digital Applications, Inc., downloaded on 3/10/2005, with a last update of 12/13/1997, downloaded from <<http://web.archive.org/web/19971221013620/http://digapp.com/>>, pages 1-2.**



**In regard to dependent claim 3**, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claim 3).

Anderson does not specifically disclose an output file with “text” content not present, hence allowing a redacted document to be producible. However, Redax teaches a method of redacting an electronic PDF document, whereby a redacted document is saved in final redacted form (i.e. redacted text is permanently removed) (Redax page 1 paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of saving the displayed redactions within a final document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents - see Redax page 1 paragraph 2). Applying Redax would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content.

**In regard to dependent claim 4**, Anderson/Pontin/Redax teaches a final-form document with annotated and/or redacted images/text are present in said document, said annotations permanently replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

**In regard to claims 11-12**, claims 11-12 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 3-4, and are rejected along the same rationale.

**In regard to claim 19**, claim 19 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 3, and is rejected along the same rationale.

**6. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, and further in view of Redax.**

**In regard to independent claim 26**, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract). Anderson also teaches a document data stream comprising redaction objects merged in the same data stream as the final form document (Anderson Abstract, column 2 lines 24-31, column 3 lines 33-43).

Anderson does not specifically teach a PDF data stream. However, Redax teaches redaction as applied to a PDF file (Redax paragraph 1). It is noted that electronic PDF files generally comprise an underlying set of instructions that includes information on said PDF document content (i.e. location data of text and images, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax's PDF file containing said instructions to Anderson's document data stream, providing Anderson the benefit of redacting PDF documents, increasing the versatility of Anderson as applied to a wider variety of document types.

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Abstract, Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line "Object Area Position"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (i.e. image objects) (Anderson Abstract, Figure 1, 3B, also column 6 lines 15-20).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose *“an output file PDF file comprising said PDF stream except for portions of said PDF data stream corresponding to said identified content”* with said (image based) content not present, hence allowing a redacted document to be producible from said output file. However, as explained above, PDF files generally contain an underlying set of instructions (i.e. content, layout instructions, etc.). Redax page 1 paragraph 3, teaches opening a (PDF) document in Acrobat Exchange. The document is searched and words are tagged and overlaid with exemption codes. Since Redax teaches that a new (PDF) document is created and saved (reflective of user editing and redacted deleted text), said new edited document reflects a new set of saved instructions accordingly. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax's redaction method to Anderson's data stream and redaction of text and images, providing Anderson the benefit of permanently saving the displayed image redactions within a final document in permanent PDF form for ultimate security (preventing document reverse-engineering, etc.).

**In regard to dependent claim 27**, Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with *“displaying all or a portion of a document”*).

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with *“manipulating a frame displayed on the document, content....visible to the user during said step of manipulation.”*), teaching the manipulation and orientation (framing) of an object on a page.

7. **Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson and Redax, as applied to claim 26 above, and further in view of Pontin.**

**In regard to dependent claim 34**, Anderson does not specifically disclose replacement via “pixel by pixel”. However, both Anderson and Pontin teach images (see Pontin page 9 paragraph 9). Since modification of images in an electronic document generally involve modification of its representative pixels , and since Pontin teaches permanent flattening of a file, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification, providing the benefit of image based redaction.

#### ***Response to Arguments***

6. Applicant's arguments filed 8/14/2006 have been fully and carefully considered but they are not persuasive.

Applicant argues on pages 10-11 of the amendment that the cited references do not teach Applicant's amended portion of independent claim 1. The examiner respectfully disagrees. Claim 1 does not appear to be directed to a PDF file, nor to a document with an underlying instruction set. Without clarification, the claimed “identified information” can be fairly interpreted as Anderson's location, size or orientation information of an annotation (or redaction), said items represented as annotation/redaction objects, as explained in the instant rejection. The examiner introduces Pontin to teach Snagit's screen-dump capability, therefore producing flattened redacted image pasted into a final document accordingly, resulting in a document with permanent image redaction.

Applicant additionally argues that claim 5 requires that it is the “designations [of the geographic region of the document for redaction]” that are saved with the document (pages 11-12 of the amendment). The examiner respectfully disagrees. Claim 5 does not claim any underlying set of instructions for the designations to be saved to. Anderson teaches a user designating a geographical area for redaction, resulting in a document

with said designated area redacted. Pontin teaches a final document with a pasted flattened redacted image, rendering said redaction permanent. At the very least, visual inspection of said final document reveals redacted areas designated accordingly with the document.

In additional support of the instant rejections, Anderson teaches annotation and/or redaction of objects accordingly. If a user wishes to redact the image of Texas (Anderson Figure 2B), it is at least obvious that the geographic region (square) surrounding Texas can be reasonably interpreted as “*designating a geographic region of the document for redaction*”. Anderson’s command entry or pull down menu includes instructions for designating location, size and orientation, which can be reasonably interpreted as manipulation of a frame (i.e. the frame of Texas).

Regarding instant claim 26, Applicant recites a PDF data stream and clarifies the relationship between a PDF file, an underlying set of instructions, and a PDF instruction stream (page 9, bottom paragraph, of amendment). Since a PDF file contains a set of instructions for describing content, layout, etc., it is at least obvious that editing said PDF file to produce a new PDF file results in a new saved set of instructions to reflect said editing.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

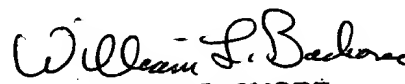
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**

October 20, 2006